

Response to Office Action and in a Substitute Sequence Listing. In the Supplemental Preliminary Amendment, applicants mistakenly asserted that the nucleotide sequences recited in originally filed SeqID Nos. 1-3 were SEQ ID NOS: 1-3, and the amino acid sequences recited in originally filed SeqID Nos. 1-3 were SEQ ID NOS: 4-6. In fact, the nucleotide sequences of originally filed SeqID Nos. 1, 2 and 3 correspond to SEQ ID NOS: 1, 3 and 5, respectively, while the amino acid sequences of originally filed SeqID Nos. 1, 2 and 3 correspond to SEQ ID NOS: 2, 4 and 6, respectively. This error was inadvertent. Applicants apologize for any inconvenience that it may have caused the Examiner.

Applicants have amended the specification to correct spelling errors and to properly recite the sequence identifiers (SEQ ID NOS.) corresponding to the sequences in the Substitute Sequence Listing filed on July 17, 1998.

Support for these amendments can be found in the originally filed Sequence Listing and in the specification, including at page 35, lines 16-20, page 46, lines 14-19, page 47, lines 1-5, and page 49, line 34 to page 50, line 3. The amendments to the specification do not add new matter because the amino acid sequences SEQ ID NOS: 2, 4 and 6 were depicted in the originally filed Sequence Listing under the corresponding codons of the nucleotide sequences.

The Claim Amendments

Applicants have amended claims 9, 28, 33, 34, 46-48, 50 and 51 to recite the sequence identifiers corresponding to the sequences in the Substitute Sequence Listing. As discussed above, the numbering of the sequence identifiers in the originally filed Sequence

Listing was changed in order to provide a separate sequence identifier for each of the amino acid sequences depicted in former Seq ID Nos. 1-3. Support for these amendments is found in the claims as originally filed and in the originally filed Sequence Listing.

Applicants have amended claim 54 to correct a typographic error and properly recite the DSM deposit number of the plasmid. Support for this amendment is found in the originally-filed specification at page 25, line 22.

Applicants have cancelled claims 27 and 42 and recast them as added claims 60 and 61, respectively. Former claims 27 and 42 included underlining, and thus have been amended by rewriting the claims. Claim 60 properly recites the sequence identifiers, SEQ ID NOS. 2, 4 and 6, corresponding to the amino acid sequences in the Substitute Sequence Listing.

Applicants have amended the claims to improve their form. Applicants have amended claim 14 to recite a seed of a transgenic plant. Applicants have amended claims 17, 20 and 56 to replace the term "containing" with "comprising." Added claim 61 also recites the term "comprising" to replace the term "containing" in originally-filed claim 42. Applicants have amended claim 26 to recite a DNA sequence. Applicants have amended claims 32-37, 43-52 and 56-59 to recite a DNA molecule. Added claim 61 also recites a DNA molecule. Applicants have amended claims 39-41 and 58-59 to recite methods of modifying the flowering behavior of plants, preventing the synthesis of an endogenous citrate synthase, or isolating homologous sequences from the genome of a plant using a DNA molecule. Applicants have amended claim 57 to recite a DNA molecule comprising control elements for its expression rather than a use of a DNA sequence in combination with control

elements for expression. Support for these amendments is found in throughout the specification and in the claims as originally filed.

None of the amendments add new matter. Their entry is requested.

The Restriction Requirement

The Examiner states that restriction is required under 35 U.S.C. § 121 and § 372. The Examiner states that the application contains the following inventions or groups of inventions which are not so linked as to form a single inventive concept under PCT Rule 13.1. Specifically, the Examiner states that there are two inventions:

Group I, claims 1-7, 15-29, 39, 40 and 42-52, drawn to transgenic plants with reduced citrate synthase activity.

Group II, claims 8-14, 16, 17, 20, 30-39 and 41-52, drawn to transgenic plants with increased citrate synthase activity.

The Examiner states that the inventions listed as Groups I and II lack the same or corresponding special technical features because the inventions of Groups I and II are drawn to two different methods of using the gene encoding citrate synthase. The Examiner states that applicants are required to elect a single invention to which the claims must be restricted in accordance with 37 C.F.R. 1.499. Applicants respectfully traverse.

The Manual of Patent Examining Procedure (MPEP) states that there are two criteria for a proper requirement of restriction between patentably distinct inventions. The first is that the inventions must be independent or distinct as claimed. The second is that there must be a serious burden on the Examiner if restriction is not required. The MPEP further states that “[i]f the search and examination of an entire application can be made

without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP § 803.

In this case, both Groups I and II share the same special technical feature of a transgenic plant having modified citrate synthase activity. Claim 60, formerly claim 27, included in Group I, recites a process of making a transgenic plant comprising expressing an antisense RNA complementary to a DNA sequence which encodes citrate synthase having an amino acid sequence of SEQ ID NOS: 2, 4 or 6. Claim 9, in Group II, recites a transgenic plant comprising a DNA sequence which encodes an amino acid sequence of SEQ ID NOS: 2, 4 or 6. Thus, Groups I and II contain overlapping subject matter. Furthermore, the transgenic plants of both Groups I and II are classified in the same class and subclass (class 800, subclass 205). Therefore, a search of the subject matter of Group I would be co-extensive with a search of Group II and there would be no serious burden for the Examiner to search both groups. Applicants also note that the International Preliminary Examination Authority acknowledged unity of invention under PCT Rule 13. For these reasons, applicants request that Groups I and II be rejoined.

The Examiner has failed to include claims 53-59 in either Group I or Group II. Claims 53-55 are drawn to plasmids comprising DNA sequences encoding a citrate synthase. These claims are similar to that of claim 52, which is included in both Groups I and II. Claim 56 is drawn to bacteria comprising a DNA molecule or a plasmid encoding a citrate synthase. This claim is similar to that of claim 20, which is included in both Groups I and II. Amended claim 57 is drawn to a DNA sequence comprising control elements for expression of the DNA sequence in prokaryotic or eucaryotic cells. This claim is similar to

that of claim 61 (formerly claim 42, which is included in both Groups I and II). Amended claim 58 is drawn to a method of using the DNA sequence to prevent the synthesis of endogenous citrate synthase in cells. Amended claim 59 is drawn to a method of isolating homologous sequences from the genome of plants using a DNA molecule encoding a citrate synthase. This method could be used to obtain the DNA molecule recited in claim 28, which is included in Group I, or in claim 32, which is included in Group II.

Conclusion

Applicants propose that claims 53-59 and added claims 60 and 61 (formerly claims 27 and 42, respectively) be considered together with the claims of rejoined Groups I and II because the subject matter of these claims are useful in developing transgenic plants with either reduced or increased citrate synthase activity or in a method of making such transgenic plants. Alternatively, if the Examiner maintains the restriction requirement between Groups I and II, applicants propose that Group I should include claims 53-59 and added claims 60 and 61, in addition to those mentioned in the Office Action, while Group II should include claims 53-57 and 59 and added claim 61, in addition to those mentioned in the Office Action.

If the Examiner does not agree with this proposal, pursuant to 37 C.F.R. § 1.143, applicants provisionally elect with traverse the amended claims of Group I for initial substantive examination. As stated above, applicants believe Group I should include claims 60-61, which replace claims 27 and 42 (classified in Group I), and claims 53-59, which were not mentioned in the Office Action. This election is made expressly without waiver of

applicants' rights to continue to prosecute and to obtain claims to the non-elected subject matter either in this application or in other applications claiming priority herefrom.

Respectfully submitted,

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